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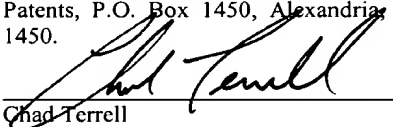
**In the United States Patent and Trademark Office
on Appeal from the Examiner to the Board
of Patent Appeals and Interferences**

In re Application of: Arshish C. Kapadia, et al.
Serial No.: 09/333,894
Filing Date: June 14, 1999
Examiner: Mark Fadok
Group Art Unit: 3625
Title: *System and Method for Promising Delivery of Configured Products
with Selected Optimizations*

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Dear Sir:

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I hereby certify that this communication is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to Mail Stop: Reply Brief, Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.	
	
Chad Terrell	
Date: October 4, 2004	
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Reply Brief

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 1.193(b)(1), in triplicate, in response to the Examiner's Answer mailed August 2, 2004.

Appellants filed an Appeal Brief on May 3, 2004, explaining clearly and in detail why the final rejection of Claims 1-4 and 6-43 is improper and should be reversed by the Board. Appellants also filed a Supplemental Appeal Brief on May 13, 2004, to update information regarding the Related Appeals and Interferences section of the Appeal Brief. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellants respectfully request the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

Status of Claims

In response to the Examiner's statement in the Examiner's Answer, Appellants clarify that Claim 5 was canceled without prejudice or disclaimer in a Response filed March 8, 2002.

Status of Amendments

In response to the Examiner's statement in the Examiner's Answer, Appellants clarify that no amendments were made by Appellants in response to the Final Office Action mailed October 30, 2003. All amendments submitted by Appellants have been entered by the Examiner.

Grouping of Claims

In the Appeal Brief, Appellants made an effort to group the claims to reduce the burden on the Board. Furthermore, in the Argument section of the Appeal Brief, where appropriate, Appellants presented reasons why particular claims subject to a ground of rejection are separately patentable from other claims subject to the same ground of rejection.

Appellants grouped the claims as follows:

1. Group 1 may include Claims 1-4, 6-9, and 28-43; and
2. Group 2 may include Claims 10-27.

The Examiner states in the Examiner's Answer that "The rejection of claims 1-4 and 6-43 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." (Answer, Page 3; emphasis in original) Appellants respectfully disagree.

In the Argument section of the Appeal Brief, Appellants addressed each Group of claims separately. In the section for each group, Appellants provided reasons why the claims of that Group are separately patentable from the claims of the other Group. For example, in addressing the claims of Group 2, Appellants stated, "Claims 10-27 are separately patentable from every other claim subject to the same ground of rejection. These claims recite limitations that are substantially different from limitations recited in other claims." (Appeal Brief, Page 16) Moreover, Appellants separately argued the claims of Group 1 and the

claims of Group 2, providing arguments for why the Examiner's proposed combination of references fails to disclose, teach, or suggest the limitations of each of those Groups. For example, with respect to the Claims of Group 2, Appellants did not merely state that these claims are patentable because they depend from certain claims in Group 1.

For at least these reasons, Appellants respectfully submit that the claims of Group 1 and the claims of Group 2 should not stand or fall together for purposes of this Appeal.

Argument

The rejection of Claims 1-4 and 6-43 under 35 U.S.C. § 103(a) as being unpatentable over the Examiner's proposed *Henson-Rhythm* combination is improper and should be reversed by the Board.

Appellants note that the Examiner's Answer consists almost entirely of substantially similar arguments to those presented in previous Office Actions. The Examiner has merely added several sentences to material repeated verbatim from these Office Actions and several sentences in response to Appellants' Appeal Brief. Below, to reduce the burden on the Board, Appellants specifically address these additional sentences and the Examiner's brief response to Appellants' Appeal Brief.

A. Even When Combined, the Proposed *Henson-Rhythm* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Appellants' Claims

In rejecting Appellants' claims, the Examiner relied on *Henson* as the primary reference but acknowledged that *Henson* does not disclose certain limitations recited in Appellants' claims. Rather, the Examiner relied on *Rhythm* for disclosure of these limitations. In the Examiner's Answer, the Examiner suggests that Appellants have argued against the references individually and that this approach is improper. (*See Answer, Page 6*) Specifically, the Examiner has stated that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (*Answer, Page 6*) Whether or not the Examiner's statement is correct in some general sense, it is wholly irrelevant to the issues presented in this Appeal. Appellants' position is and has

always been that: (1) the Examiner's proposed *Henson-Rhythm* combination is improper; and (2) even if the proposed *Henson-Rhythm* combination was proper, the proposed combination would still fail to disclose, teach, or suggest each and every limitation in Appellants' claims at least because each of the references in the proposed combination fails to disclose, teach, or suggest various limitations recited in Appellants' claims.

1. Group 1 (Claims 1-4, 6-9, and 28-43)

For example, in the Appeal Brief and throughout prosecution, Appellants demonstrated that neither *Henson*, *Rhythm*, nor their proposed combination discloses, teaches, or suggests at least the following limitations recited in independent Claim 1 (and similarly in independent Claims 28 and 36):

- *during a product configuration session*
- *for each of a series of selection option sets*
- *dynamically applying an optimization function with respect to each item in the selection option set*
- *according to data received from an available-to-promise engine during the product configuration session*
- *to identify an item of the selection option set as a default selection*
- *the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function*

(Appeal Brief, Pages 9-14).

With regard to *Henson* specifically, Appellants have repeatedly demonstrated throughout prosecution that, at a minimum, *Henson* fails to disclose, teach, or suggest “*during the configuration session, for each of the series of selection option sets, dynamically applying an optimization function with respect to each item in the selection option set according to the data received from the available to promise engine during the configuration session to identify an item of the selection option set as a default selection, the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function,*” as recited in Claim 1, for example.

Furthermore, also as demonstrated during prosecution and in Appellants' Appeal Brief, the secondary reference *Rhythm* merely mentions optimization in the context of supply chain management activities such as planning and scheduling. (See, e.g., Pages 1 ("solutions"), 6-7 ("advanced scheduling"), 15 ("distribution planning"), 19-20 ("manufacturing planning")) The only portion of the *Rhythm* reference even marginally related to configuring a product, entitled "order promising," is entirely devoid of any mention of optimization. (See Page 3 ("order promising"))

As Appellants have repeatedly demonstrated, the teachings on Page 7 of *Rhythm* fail to disclose, teach, or suggest "***dynamically applying an optimization function with respect to each item in the selection option set,***" in contrast to the Examiner's arguments in the Examiner's Answer. (See Answer, Page 6) The Examiner now also states that "as can be seen in the *Henson* reference, the 'option set' has a function applied to it to determine if the shipment date is optimal to the customer based on the options added." (Answer, Page 6; emphasis added) First, the cited portion of *Henson* does not even use the word "optimal" as introduced by the Examiner. (See Column 7, Lines 1-11) Second, even assuming that the Examiner's statements are true (which Appellants do not concede), *Henson* still includes no disclosure, teaching, or suggestion whatsoever of optimization, optimizer, optimal, or the like. Thus, even assuming that the cited portion of *Henson* could be summarized in the manner the Examiner proposes, it would still have no bearing on Appellants' claims.

As made clear in Appellants' claims, during prosecution, and in the Appeal Brief, it is not any particular optimization functions that Appellants seek to patent, but instead ***the dynamic application of an optimization function, with respect to each item in each of a series of selection options sets during a product configuration session, according to data received from an available-to-promise engine during the product configuration session, to identify an item of each selection option set as a default selection that is optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function.*** The newly-cited teachings of *Henson* do not in any way teach such "dynamic application of an optimization function."

Also as Appellants have repeatedly demonstrated, the “*order promising*” section beginning on Page 4 of the *Rhythm* reference clearly fails to disclose, teach, or suggest dynamically applying an optimization function with respect to each item in the selection option set “***according to data received from an available-to-promise engine during the configuration session,***” as recited in Claim 1, in contrast to the Examiner’s arguments in the Examiner’s Answer. The Examiner now also states that “Henson also teaches an available to promise engine, which offers a function that checks the compatibility and the lead-time with ‘option sets’ that are added to the configuration engine.” (Answer, Page 7) However, even assuming that the Examiner’s statements are true (which Appellants do not concede), *Henson* still includes no disclosure, teaching, or suggestion whatsoever of optimization, optimizer, optimal, or the like. This disclosure in the *Henson* reference is wholly insufficient to meet the recited limitations of dynamically applying an optimization function with respect to each item in the selection option set “***according to data received from an available-to-promise engine during the configuration session.***”

Also as Appellants have repeatedly demonstrated, the “*manufacturing planning*” section beginning on Page 19 of the *Rhythm* reference clearly fails to disclose, teach, or suggest dynamically applying an optimization function with respect to each item in the selection option set “***to identify an item of the selection option set as a default selection,***” in contrast to the Examiner’s position in the Examiner’s Answer. (See Answer, Page 7)

Also as Appellants have repeatedly demonstrated, the portions of *Rhythm* on which the Examiner’s relies as disclosing, teaching, or suggesting dynamically applying an optimization function with respect to each item in the selection option set to identify an item of the selection option set as a default selection, “***the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function,***” fail to do so.

For at least these reasons, *Henson*, *Rhythm*, and the proposed *Henson-Rhythm* combination fail to disclose, teach, or suggest the limitations specifically recited in independent Claims 1, 28, and 36. Independent Claims 1, 28, and 36 and their dependent claims are therefore patentable over the proposed *Henson-Rhythm* combination. Appellants

respectfully submit that the rejection of these claims is improper and should be reversed by the Board.

2. Group 2 (Claims 10-27)

As another example, in the Appeal Brief and throughout prosecution, Appellants demonstrated that neither *Henson*, *Rhythm*, nor their proposed combination discloses, teaches, or suggests at least the following limitations recited in independent Claim 10 (and similarly in independent Claim 20), for example:

- *during the configuration session, for each of the selection option sets, identifying as a default selection an item that provides an optimized result according to a selected optimization function dynamically applied with respect to each item in the selection option set according to the data received from the available-to-promise engine during the configuration session; and*
- *for each selection option set, before presenting the selection option set to the user, determining which of the items of the selection option set are actually available to the user in accordance with a user-specified date constraint and presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint."*

With respect to "*for each selection option set, before presenting the selection option set to the user, determining which of the items of the selection option set are actually available to the user in accordance with a user-specified date constraint,*" the Examiner argues that the proposed *Henson-Rhythm* combination discloses these limitations. However, as Appellants have repeatedly demonstrated, *Henson* discloses providing to the user a warning indicator to indicate an option which, if already selected or selected in the future by the user, would represent an invalid configuration or would adversely impact a shipment or delivery date of the configured product. Using the system disclosed in *Henson*, as clearly illustrated in Figure 4 of *Henson*, the user is presented with all options and remains free to at least initially select any of these options.

With respect to "*and presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint,*" the Examiner acknowledges that *Henson* fails to disclose teach or suggest "in accordance with a user-specified date constraint." (Answer Page 8) The Examiner relies on an article about Rhythm by Gary S. Vasilash as disclosing this limitation. (See Answer, Page 8) Appellants

note that they are not aware of this article as being in the record for this Application and that a copy was apparently not attached to the Examiner's Answer. In any event, even assuming for the sake of argument that this article discloses, teaches, or suggests that "an available to promise engine 'determines whether goods can be delivered by the specified date,'" (Answer, Page 8; emphasis in Answer), the proposed combination of references would still fail to disclose, teach, or suggest "*for each selection option set, before presenting the selection option set to the user . . . and presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint*," as recited in Claim 10.

For at least these reasons, *Henson*, *Rhythm*, and the proposed *Henson-Rhythm* combination fail to disclose, teach, or suggest the limitations specifically recited in independent Claims 10 and 20. Independent Claims 10 and 20 and their dependent claims are therefore patentable over the proposed *Henson-Rhythm* combination. Appellants respectfully submit that the rejection of these claims is improper and should be reversed by the Board.

B. The Examiner's Proposed *Henson-Rhythm* Combination is Improper.

In their Appeal Brief (and throughout the prosecution of this Application), Appellants explained why there is no requisite teaching, suggestion, or motivation in the prior art for one of ordinary skill in the art at the time of invention to have been motivated to combine the references in the manner the Examiner proposes. (See, e.g., Appeal Brief, Pages 14-16). Appellants reiterate the heavy burden incumbent on the Examiner to demonstrate a *prima facie* case of obviousness. Moreover, Appellants respectfully note, "[T]he factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001). Thus, the burden is on the Examiner to identify concrete evidence in the record to support his conclusion that it would have been obvious to modify the teachings of the cited references to achieve the claimed invention. See, *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000). The Examiner's assertion that it would have been obvious to combine *Henson* with *Rhythm* fails to provide a thorough and searching factual inquiry and does not identify any concrete evidence in the record for combining these references in a manner that would have any bearing on Appellants' claims. The Examiner's conclusions

merely provide an alleged advantage of combining the teachings of *Henson* with the teachings of *Rhythm*. Additionally, Appellants maintain that the Examiner has employed the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit.

Since the Examiner has not provided a sufficient teaching, suggestion, or motivation in the prior art, the Examiner's conclusion of obviousness is improper under the M.P.E.P. and governing Federal Circuit case law. For at least this additional reason, Appellants respectfully submit that the rejection of Appellants' claims is improper and should be reversed by the Board.

Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Appellants believe no fees are due; however, the Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: October 4, 2004

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